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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,668	09/21/2001	Yoram Ofek	SYN 1780	6833
20787	7590	09/09/2005	EXAMINER	
SITRICK & SITRICK 8340 N LINCOLN AVENUE SUITE 201 SKOKIE, IL 60077			PASCAL, LESLIE C	
			ART UNIT	PAPER NUMBER
			2633	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/960,668

Applicant(s)

OFEK ET AL.

Examiner

Leslie Pascal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,8,13-17,21,26-50,53-58 and 61-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,9-12,18-20,22-25,51,52,59 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. The applicants elect with traverse species VIII, which corresponds to figure 14. They further elect subspecies D, H and L; which correspond to figures 30, 15A ad 19A. The claims that read on these figures are claims 1-3, 5-6, 9-12, 18-20, 22-25, 51-52, 59 and 60. When the 112 problems are corrected and if claim 3 positively recites the tunable receivers, claim 3 and all claims depending thereon will no longer read on the elected invention (which does not have tunable receivers).

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 5-6, 9-12, 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites, "Comprised of at least one of the following" and continues with a list of elements. One of the elements is "a plurality of tunable receivers", yet goes onto further say that the "each of switch controllers is responsive to the CTR for tuning the tunable receivers". It appears that the tunable receivers are not required by the preamble, yet goes on to further limit that the CTR controls the receivers which would require that the tunable receivers are required. In that the elected embodiments do not have tunable receivers, if the tunable receivers are required by claim 3 (and all dependent claims), it would appear that these claims will not be included in further office actions. It is unclear whether the "tunable receiver" is positively recited or not (i.e. whether the tunable receiver is required by the claim or not). In regard to claims 5 and 6, it is unclear what is meant by "each of the subsets of the communications links is

called "the input". It is not clear that ONE input going into each of the star couplers is further limited by calling it a "subset" as opposed to "the input". In claim 6, It is further unclear what is meant by "mutually exclusive".

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in regard to claim 6, the specification does not use the terminology "mutually exclusive".

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 5-6, 9-12, 18-20, 24-25, 51-52, 59-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-33 and 40 of copending Application No. (09/960212-US2002/0063927). Although the conflicting claims are not identical, they are not patentably distinct from each other because 2002/0063927 claims a first and second switch (claim 33, lines 3-5, a CTR (line 9), plural inputs and outputs (lines 15-16) the signals from the input to the output must inherently be transmitted over at least one channel, a switch controller connected to the CTR (claim 55) which is inherently connected to other elements of the switch in order to control the elements of the switch. In regard to the coupling from the input ports to the respective output ports, see the last 7 lines of claim 33 which are the same as claim 2 of the instant application. With regard to the wavelength conversion, this relates to the mapping of the wavelengths. In regard to claim 3, 9-12 and 5-6, see claim 30 and 32 of 2002/0063927. In regard to claims 18-19, see claims 42-43 of 2002/0063927. In regard to claim 24, in that the wavelengths are tuned according to the mapping, it is inherent that there are wavelength converters. In regard to the alignment means, see claim 40.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 22-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-33 and 40 of copending Application No. 2002/0063927 in view of either Gilhousen et al (204/0156427) or Ofek (6674754). Although 2002/0063927 does not specifically claim

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that the CTR is derived from a UTC standard, Gilhousen et al (page 5, paragraph 64) teaches synchronizing a common time reference to a UTC and Ofek claims such (claims 8-9). It would have been obvious to synchronize to a standard in order to ensure that the systems are synchronized to other systems.

This is a provisional obviousness-type double patenting rejection.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bottle (5303077) in view of Harrington (Synchronization Techniques for Various Switching Network Topologies).

Bottle et al teach a first and second switch (10) in which each switch has plural inputs and outputs, which are connected over at least one channel according to a switch controller (16). Although Bottle does not teach specifics about his common timing, Harrington teaches in figure 7 that it is well known to use a common timing means for switches. It would have been obvious to use a common timing means of Harrington in the system of Bottle in order to provide proper synchronization between switches. In regard to claim 2, it would have been obvious to forward a signal through the first switch at a first time frame and through the second switch during a second predetermined time frame since it must go through the first switch first.

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10. Claims 3, 5-6, 9-12, 18, 24-25 and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bottle (5303077) in view of Harrington (Synchronization Techniques for Various Switching Network Topologies) in view of Suzuki et al (5005166).

Although Bottle et al do not teach specifics about his switches, Suzuki et al teach that it is well known for a switch to have alignment means (10A), stars (brancher, which acts as a star, 11-1), and cmbnr (12-1, which acts as a multiplexer by combining the wavelengths together). It would have been obvious to use the specific elements taught by Suzuki et al to provide the switching function of Bottle et al. In regard to claims 5-6, the input is considered to be a subset similar to the applicant's subset. In regard to claim 18, it is well known to use a timing signal at an input and use a reference timing signal in order to provide timing that is consistent throughout a communications system. Before retiming, the signals would obviously be phase independent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Pascal whose telephone number is 571-272-3032. The examiner can normally be reached on Monday, Friday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571-272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie Pascal  
Primary Examiner  
Art Unit 2633